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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,991

09/22/2006

Gianluigi Basile

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28147

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EXAMINER

MCMILLAN, JESSICA L

ART UNIT

PAPER NUMBER

2875

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,991	Applicant(s) BASILE, GIANLUIGI	
	Examiner JESSICA L. MCMILLAN	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/22/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/03/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrow (US 5,669,691) in view of Dueker et al. (US 7,088,222 B1).

Regarding claims 4-6, Barrow discloses a half-level light signaling device comprising: a casing (see figures 5 and 7) having a lower part which houses electrical and/or electronic circuits and at least one light source, the casing disposed below a ground level; a cap (cover; figure 5, column 4, lines 33-35) mounted to the casing and protruding above the ground level, the cap being removably fastened to said lower part, the cap having at least one aperture, a prism (20) disposed in the at least one aperture (22), the prism directing a light beam received from the light source; but is silent about an antenna and the cap being made of a non-metallic material or synthetic resin (claim 5).

Dueker et al. disclose a ruggedized illuminating marking or signaling device and system comprising an antenna to facilitate communication (see column 10, lines 1-6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an antenna in the signaling device of Barrow as taught by Dueker

et al. in order for the signaling device to be able to communicate by transmitting a signal.

Barrow discloses the claimed invention except for the cap being made of a non-metallic material such as synthetic resin. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the cap of Barrow from a non-metallic material such as synthetic resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. One would be motivated to do so because forming the cap of Barrow of a non-metallic material would allow the cap of the signaling device to be stronger and allow an air tight seal so that water or particles can enter the device.

Regarding claims 7 and 8, Barrow discloses a half-level light signaling device comprising; a casing (see figure 5 and 7) having a lower part which houses electrical and/or electronic circuits and at least one light source, the casing disposed below a ground level; a cap (cover; figure 5, column 4, lines 33-35) mounted to the casing and protruding above the ground level, the cap being removably fastened to said lower part; and a prism (22) but is silent about at least one antenna and the cap being made of a non-metallic material.

Dueker et al. disclose a ruggedized illuminating marking or signaling device and system comprising an antenna to facilitate communication (see column 10, lines 1-6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an antenna in the signaling device of Barrow as taught by Dueker

et al. in order for the signaling device to be able to communicate by transmitting a signal.

Dueker et al. disclose a ruggedized illuminating marking or signaling device and system comprising an antenna to facilitate communication (see column 10, lines 1-6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an antenna in the signaling device of Barrow as taught by Dueker et al. in order for the signaling device to be able to communicate by transmitting a signal.

Barrow discloses the claimed invention except for the cap being made of a non-metallic material such as synthetic resin. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the cap of Barrow from a non-metallic material such as synthetic resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. One would be motivated to do so because forming the cap of Barrow of a non-metallic material would allow the cap of the signaling device to be stronger and allow an air tight seal so that water or particles can enter the device.

Regarding claim 9, Barrow discloses a method for producing a half-level light signaling device comprising; providing a casing having a lower part which houses electrical and/or electronic circuits and at least one light source, the casing being disposable below a ground level; providing a mold having a cavity shaped to correspond to a shape of a cap for mounting to the casing, the cap protruding above the ground level, the cap being removably fastenable to said lower part of said casing; and placing

a prism into the cavity and embedding the prism in the insulating material such that the prism is located for directing a light beam received from the at least one light source disposed in the lower part of the casing; but is silent about an antenna.

Dueker et al. disclose a ruggedized illuminating marking or signaling device and system comprising an antenna to facilitate communication (see column 10, lines 1-6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an antenna in the signaling device of Barrow as taught by Dueker et al. in order for the signaling device to be able to communicate by transmitting a signal.

Response to Arguments

Applicant's arguments with respect to claim 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA L. MCMILLAN whose telephone number is (571) 272-5510. The examiner can normally be reached on 8:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sandra L. O'Shea/
Supervisory Patent Examiner, Art
Unit 2875

JLM
March 5, 2009